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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/200,743	11/30/98	BENNEKER	F 068540002-US

BUSCHER, MARK  
SYNTHON PHARMACEUTICALS LTD.  
12923 LIVIA DRIVE  
CATHARPIN VA 20143

HM12/0426

EXAMINER

CHANG, C

ART UNIT

PAPER NUMBER

1625

DATE MAILED:

04/26/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

# Office Action Summary

Application No.  
09/200,743

Applicant(s)  
Benneker et al.

Examiner  
Celia Chang

Group Art Unit  
1625



☐ Responsive to communication(s) filed on \_\_\_\_\_

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 1 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claims

☒ Claim(s) 30-39 is/are pending in the application.

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☐ Claim(s) \_\_\_\_\_ is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☒ Claims 30-39 are subject to restriction or election requirement.

## Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been  
☐ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

Art Unit: 1625

### DETAILED ACTION

1. The prosecution of this application is reopen.
2. Claims 30-39 are in the case.
3. A reviewing of the claims indicated that distinct and independent inventions are being claimed. Therefore, a restriction is required.

#### *Restriction*

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 30-38, drawn to paroxetine methane sulfonate crystalline, composition thereof and method of using thereof, classified in class 546, subclass 197 and class 514 subclass 321.
- II. Claim 39, drawn to process of making paroxetine hydrochloride, classified in class 546, subclass 197.

The inventions are distinct, each from the other because:

Group I and Group II are independent and distinct inventions because Group I invention is drawn to the sulfonate salt of paroxetine, its composition and use which depends on the patentability of the product *per se*. Group II invention is a process of making a hydrochloride salt of paroxetine and the patentability of the process depends on the steps, operating conditions and reactive parameters. Therefore, group II process is unrelated to group I compound *per se* invention, and a restriction is required.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Celia Chang whose telephone number is (703) 308-4702. The examiner can normally be reached on Monday through Thursday from 8:30 am to 5:00 pm.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1235.

CCC/Chang  
Apr. 18, 2001

  
CEILA CHANG  
PRIMARY EXAMINER  
GROUP 1200-1685